

REMARKS

Applicants thank the Examiner for the thorough examination of the application. No new matter is believed to be added to the application by this amendment.

Entry Of Amendment

Entry of this Amendment under 37 C.F.R. §1.116 is respectfully requested because it cancels claims and places the application in condition for allowance. Alternately, entry is requested as reducing issues for appeal.

Status Of The Claims

Upon entry of this Amendment, Claims 1-25 are pending in the present application. This Amendment cancels claims 26-30 and incorporates their subject matter into independent claims 1, 4, 8, 13 and 15, respectively. The claims have been further amended to correspond to the amendments to independent claims 1, 4, 8, 13 and 15.

Objection To The Drawings

The Examiner objects to the amended drawings filed December 21, 2005. The Examiner asserts that there is insufficient evidence to withdraw the "Conventional Art" legend from Figs. 9A and 9B.

At page 2 of the Office Action, the Examiner asserts that the Declaration signed on November 30, 2005 (and filed with the Amendment of May 24, 2006) was not executed by all of the inventors. However, there is no requirement that all the inventors must sign a Declaration.

Also, as noted in the Declaration, the true intent of the inventors that Fig. 9A and Fig. 9B should illustrate the invention can be readily ascertained from the location of the discussion of Fig. 9B being located in the Detailed Description section of the specification. The substitute specification at page 12, lines 30-32 states: "FIG. 8 is a simplified block diagram of a personal computer which the filed management *according to the present invention . . .*" (Emphasis added). After a brief discussion of the operating system, the specification relates Fig. 9B to inventive Fig 8 at page 13, lines 12-15: "In the meantime, all information about files recorded in the rewritable DVD 1 is written in the hierarchically-structured tables shown in FIGS. 4A, 9A, and 9B."

As a result, the specification clearly shows that Fig. 9A and Fig. 9B relate to an embodiment of the invention. Thus the removal of the legend "Conventional Art" is proper.

Rejections Based On Kuba

Claims 1-11 and 13-25 are rejected under 35 U.S.C. §102(b) as being anticipated by Kuba (U.S. Patent 5,806,072). Claims 1-11 and 13-25 are rejected under 35 U.S.C. §103(a) as being obvious over Kuba in view of D-Store (D-Store IBM Microdrives). Claim 12 is rejected under 35 U.S.C. §103(a) as being obvious over Kuba (alone and in view of D-Store) and further

in view of ECMA (ECMA-167). Claims 26-30 are rejected under 35 U.S.C. §103(a) as being obvious over Kuba in view of Taussig (U.S. Patent 6,590,607). Applicants traverse.

The present invention pertains to a file managing system for a DVD (independent claims 1, 4, 8, 13 and 15). In previous responses, the failures of Kuba (which pertains to memory cards) to disclose or suggest a file management system for a DVD have been thoroughly discussed.

At pages 3-6 of the Office Action the Examiner maintains the position that the invention is unpatentable over Kuba and D-Store. Notably, at page 5, lines 12-14, the Examiner states: "With respect to claims 1-15, Examiner disagrees, again noting that those claims do not recite a DVD but merely the broader limitation of "rewritable disk." However, the independent claims of the present invention are now drawn to a DVD and are thus clearly patentable over Kuba and D-Store.

At page 6, lines 18-19 of the Office Action, the Examiner again points to Kuba at column 22, lines 55-61, which includes that statement: "While the above description concerned with the IC memory card camera, it is more effective to use optomagnetic disks or like large capacity storage media in lieu of the IC memory card 14." However, this statement fails to disclose or suggest a DVD, such as is set forth in the independent claims of the present invention.

Also, D-Store pertains to a micro-drive having dimensions of 36.4 mm by 42.8 mm.

In contrast, a DVD has a larger size than the memory card of Kuba or the micro-drive of D-Store. For example, Standard ECMA-267 sets forth a DVD size of 120 mm¹, which is much larger than the size of a camera memory card or a micro-drive.

At pages 20 and 21 of the Office Action, the Examiner adds ECMA to Kuba and D-Store to reject claim 12. However, ECMA fails to address the deficiencies of Kuba and D-Store in suggesting a claimed embodiment of the present invention.

At page 21, lines 15-20 of the Office Action, the Examiner points to column 3, lines 22-38 of Taussig for teachings pertaining to a DVD used in a video camera. However, Taussig at column 3, lines 26-27 teaches “an 8 cm digital video disk (DVD).” This 8 cm (80 mm) DVD is much larger and thus fundamentally different from the memory card of Kuba (and the micro-drive of D-Store). One of ordinary skill would have no motivation to combine the dissimilar art of Taussig with Kuba to produce a claimed embodiment of the invention, such as is set forth in independent claims 1, 4, 8, 13 and 15.

As a result, Kuba clearly fails to anticipate the present invention. The combination of Kuba with any iteration of the secondary references would fail to motivate one of ordinary skill in the art to produce an embodiment of the invention using a DVD, such as is set forth in claims 1, 4, 8, 13 and 15. A *prima facie* case of obviousness has thus not been made. Claims depending upon claims 1, 4, 8, 13 and 15 are patentable for at least the above reasons.

These rejections are overcome and withdrawal thereof is respectfully requested.

¹ See <http://www.ecma-international.org/publications/files/ECMA-ST/Ecma-267.pdf>

Prior Art

The prior art cited but not used by the Examiner show the status of the conventional art that the invention supersedes. No additional remarks are accordingly necessary.

Foreign Priority

The Examiner has acknowledged foreign priority in the Office Action mailed August 27, 2003.

CONCLUSION

For the foregoing reasons and in view of the above clarifying amendments, Applicants respectfully request the Examiner to reconsider and withdraw all of the rejections of record, and earnestly solicit an early issuance of a Notice of Allowance.

Should there be any outstanding matters which need to be resolved in the present application, the Examiner is respectfully requested to contact Robert E. Goozner, Ph.D. (Registration No. 42,593) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

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Respectfully submitted,

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